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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,159	08/23/2001	Paul Clinton Coffin	10012828-1	1251

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

TRAN, HANH VAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,159

Applicant(s)

COFFIN ET AL

Examiner

Hanh V. Tran

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24-29,35 and 37-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24-29,35 and 37-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 8/9/2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 50-52 are rejected under 35 U.S.C. 102(e) as being anticipated by USP 6,648,428 to Chaloner et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Chaloner et al discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 1-2, a data storage system housing 70 having an opening, first and second elongate reference rails 272,274, Fig 7, located adjacent the opening, a plurality of media storage devices 30,32

Art Unit: 3637

each having a housing movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, first and second elongate alignment grooves 276,278 adapted to slidably engage with the first and second elongate reference rails 272,274, Fig 21, of the data storage system housing, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle operationally attached to the housing, a side portion of the housing having a plurality of slots configured to receive the data media, a plurality of dividers positioned in spaced-apart relation within the housing, supplemental slots (defined as the spaced between plate 124 and the front 62) separate from the media storage device, means for applying a force, guide rails 36, Figs 7-8, to enable movement of the drawer between the retracted and extended positions, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate reference rails and the elongate alignment grooves and guiding the media storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis transverse to the longitudinal axis. Further, it is well known that a data storage system would include a data exchange device for reading data from the data media, and a media handling system for transferring data media from the media storage device to the data exchange device.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 21-22, 24-29, 35, 37-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,116,063 to Foslien in view of USP 6,042,205 to Coffin et al and USP 5,537,371 to Niederlein et al.

Foslien discloses a data storage system 10 comprising all the elements recited in the above listed claims including, such as shown in Figs 1-3, a system housing 30 having an opening, a media storage device 54 having opposite sides located between the top and bottom and extending parallel to the longitudinal axis, at least one of the opposing sides being configured to receive the data media and a plurality of slots 56,58 defined by a plurality of dividers positioned in space-apart relation within the media storage device housing (such as shown in Fig 2), a data exchange device (not shown), a media handling system (not shown), a locking plate, a handle 142 configured to enable an operator to apply a force, a plurality of movable drawers 54, guide rails (not numbered, such as shown in Fig 2) positioned at the bottom of the drawer to enable

movement of the drawer between the retracted and extended positions, supplemental slots separate from the media storage device (defined as the space between the media storage device and the front/locking plate of the drawer), wherein the media storage devices stacked in a vertical stack arrangement,.

The differences being that Foslien does not clearly disclose the system housing having first and second elongate reference rails located adjacent the opening, the media storage device having first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures, a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage and secure the data media in respective slots, an automated drive system adapted to, in response to user input, move the drawer between a retracted position and an extended position, the drive system including a motor, and a drive gear driven by the motor, and the supplemental slots are defined by one or more slot dividers.

Coffin '205 the idea of providing a media storage device housing with a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for

the purpose securing the data media within the media storage device housing. While Niederlein teaches that it is well known in the art to provide the system housing with first and second elongate reference rails located adjacent the opening, the media storage device with first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures for the purpose of facilitate moving the drawer between the retracted and extended positions. Therefore, it would have been obvious to modify the structure of Foslien by providing a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for the purpose securing the data media within the media storage device housing, as taught by Coffin et al, and providing the system housing having first and second elongate reference rails located adjacent the opening, the media storage device having first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures for the purpose of facilitate moving the drawer between the retracted and extended positions, as taught by Niederlein, since the references teach alternate conventional media storage device, used for the same intended purpose, thereby providing structure as claimed. In regard to an automated drive system adapted to, in response to user input, move the drawer between a retracted position and an extended position, the drive system including a motor, and a drive gear driven

Art Unit: 3637

by the motor, it is well known in the art to provide a data storage system with such automated drive system in order to facilitate opening and closing of the drawer, thus it would have been obvious to modify the structure of Foslien by providing the data storage system with an automated drive system adapted to, in response to user input, move the drawer between a retracted position and an extended position, the drive system including a motor, and a drive gear driven by the motor in order to facilitate opening and closing of the drawer. In regard to the supplemental slots are defined by one or more slot dividers, it is well known in the art to provide the interior of a drawer with one or more slot dividers in order to provide an organized drawer.

Response to Arguments

7. Applicant's arguments filed 8/9/2006 have been fully considered but they are not persuasive. In response to applicant's arguments on pages 15-16 regarding the limitation in claim 50 of the supplemental slots, the examiner takes the position that although Chaloner may not specifically stated what that space is used for, the claimed language fails to provide adequate structural limitations in order to distinguish applicant's claimed invention from the prior art of record, and the space shown in the drawing of Chaloner clearly meets the claimed limitations of supplemental slots (applicant is reminded that spare data media is not positively claimed).

8. Applicant's arguments with respect to claims 21-22, 24-29, 35, 37-49, 53-67 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HVT *HVT*
October 30, 2006

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